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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

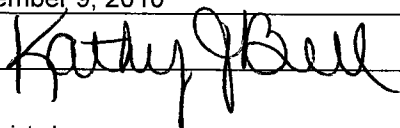
16113-0761001

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name Kathy J. Bell

Application Number

10/750,361

Filed

December 31, 2003

First Named Inventor

Nelson Minar

Art Unit

3688

Examiner

Donald Champagne

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 62,371☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_



Signature

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Telephone number

September 9, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

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\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Nelson Minar	Art Unit	: 3688
Serial No.	: 10/750,361	Examiner	: Donald Champagne
Filed	: December 31, 2003	Conf. No.	: 4924
Title	: EMBEDDING ADVERTISEMENTS IN SYNDICATED CONTENT		

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REASONS FOR PRE-APPEAL CONFERENCE REQUEST

In reply to the Final Office Action of June 10, 2010, Applicant submits a Notice of Appeal, a Pre-Appeal Brief Request for Review, and the following reasons for the Pre-Appeal Conference Request.

Claims 1, 2, 11-13, 17-19, 23-25, 35-37, 42, 57-64, and 72-78 stand rejected under 35 U.S.C. 102(b) as allegedly being unpatentable over Sheth (U.S. Patent No. 6,311,194) and under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sheth in view of RSS Advertising (archived weblog made of record). Applicant respectfully submits that the Examiner has made clear errors in interpreting the claims and in finding that Sheth or the asserted combination of Sheth and RSS Advertising disclose “inserting ... the first targeted ad item at a location in the RSS feed [that] is adjacent to the first syndicated content item in the RSS feed ... in response to a request for the RSS feed,” as recited by claim 1.

I. Claim Interpretation

At pages 3 and 4 of the office action, the Examiner asserts that “RSS, Real Simple Syndication, and Atom are indefinite. The examiner has interpreted these to be ‘names used in trade,’ which are permissible if “in this country, their meanings are well-known and satisfactorily defined in the literature.” The Examiner asserts that this condition is not satisfied.

In spite of asserting that the meanings of RSS and Real Simple Syndication are not well-known, the Examiner has cited the RSS Advertising reference, which not only consistently references RSS feeds, but also provides several code examples of RSS feed items provided by users. Thus, the RSS Advertising reference demonstrates that the meaning of RSS was well-known at the time that the present application was filed. Additionally, according to

<http://web.resource.org/rss/1.0/>, the RSS 1.0 specification was released December 6, 2000. Accordingly, not only was the meaning of RSS well-known at the time that the present application was filed, but RSS was also satisfactorily defined by the RSS 1.0 specification, which was released prior to the filing of the present application. For at least this reason, the terms RSS and Really Simple Syndication are not indefinite.

At page 2 of the office action, the Examiner “interprets RSS and Atom to be programming rules or guidelines, comparable to a book of grammar rules or guidelines for writing effective English ... that are themselves non-functional descriptive material and accordingly not given patentable weight.” Applicant disagrees because the recitation of RSS (and Atom) in the claim language specifies a specific type of data that is being received, inserted, and provided. For example, an application on a user device that retrieves RSS feeds can process data that is provided in the RSS format and present content corresponding to the data to the user. However, if the data that is provided is not in a proper format (e.g., the RSS format), the content of the RSS feed will not be presented to the user. Therefore, claim 1 specifies that an RSS feed item (i.e., the first targeted ad item) is received and inserted to ensure that the RSS feed provided in response to a request for the RSS feed is RSS compliant (i.e., can be presented by a user device). Atom data has similar properties. Thus, the terms RSS and Atom are functional elements, and it is clear error to construe RSS and Atom to be nonfunctional descriptive material.

## II. Sheth

According to the Abstract, Sheth discloses a “metabase”:

A system and method for creating a database of metadata (metabase) of a variety of digital media content, including TV and radio content delivered on Internet. This semantic-based method captures and enhances domain or subject specific metadata of digital media content, including the specific meaning and intended use of original content. To support semantics, a WorldModel is provided that includes specific domain knowledge, ontologies as well as a set of rules relevant to the original content. The metabase may also be dynamic in that it may track changes to the any variety of accessible content, including live and archival TV and radio programming.

This “metabase” is created using “an extractor program [that] takes HTML pages and extraction rules as inputs and generates assets such as that shown by FIG. 6. ... Once created, the assets are sent to a Metabase Agent that is in charge of enhancing and inserting them into a

database of records. ... After insertion into the metabase, the assets are then easy to be searched.” Sheth at col. 10, lines 43-54.

Sheth notes that the metabase can be used in a form of “targeted advertising [that] would involve creating an **XML string that represents queries that the user performs or individual media assets** in which the user has shown interest. This XML string could then be sent to an external advertisement provider along with a user’s session and profile information. The advertisement provider would process this information and return a URL reference to a semantically targeted advertisement.” Id. at col 16, lines 37-44.

### III. RSS Advertising Reference

The RSS Advertising reference (“RSS Advertising”) is an archived web log that includes user posts related to “embedding text ads into RSS feeds.” RSS Advertising at page 1. RSS Advertising also includes user posts that recite code for RSS feed items.

### IV. The Claimed Subject Matter

Independent claim 1 recites “inserting ... the first targeted ad item at a location in the RSS feed [that] is adjacent to the first syndicated content item in the RSS fee ... **in response to a request for the RSS feed.**” Paragraph 0014 of the published application notes that “targeted ads(s) are inserted in response to a request for syndicated material, as opposed to being included in the syndicated material at the time the syndicated material was generated, the ad can be kept current and timely even when displaying web logs and/or news feeds which may be months or years old.” Paragraph 0044 similarly notes that “while a web log or other syndicated information may age and be years old, the targeted ads presented to the user as part of the syndicated information provided in response to a user retrieval request, as well as ad information used to select and/or score the ad, can be kept current. Thus, the syndicated information may be older than the ad or ads inserted into the syndicated information.”

The plain and ordinary meaning of the claim language as well as the text of the specification make it clear that the first targeted ad item **is inserted in response to a request for the RSS feed** by a user. Thus, the claimed subject matter clearly specifies that targeted ad items are dynamically inserted at specified locations following a request for an RSS feed rather than being embedded in the original RSS feed.

### V. Sheth Fails to Disclose Inserting an Ad Item in Response to a Request for an RSS Feed

At page 5 of the office action, the Examiner asserts that col. 16, lines 52-55 of Sheth disclose "inserting ... the first targeted ad item ... in response to a request for the RSS feed." This relied-upon portion of Sheth recites "if the content provider is sent an XML string similar to the one sent to the ad provider, the content provider is able to tailor the advertisements in their own page." First, applicant notes that at no point does Sheth disclose an RSS feed. Therefore, Sheth cannot be properly construed as disclosing insertion of RSS feed items into an RSS feed.

Second, the XML string referred to in this passage is not a targeted ad item that is inserted into an RSS feed. Rather, **the XML string** of Sheth is merely a "metabase" record that **"represents queries that the user performs or individual media assets in which the user has an interest."** As described at lines 40-44 of column 16, "this XML string could then be sent to an external advertisement provider along with the user's session and profile information. The advertisement provider would process this information and **return a URL reference to a semantically targeted advertisement.**" This portion of Sheth makes clear that the XML string is data used to select advertisements for presentation with a web page, rather than an advertisement or an RSS feed item that is inserted into an RSS feed. Additionally, Sheth provides no disclosure that an RSS feed item (i.e., the first targeted ad item) is inserted into a requested RSS feed in response to the request. Therefore, Sheth cannot be properly construed as disclosing insertion of "the first targeted ad item at a location in the RSS feed [that] is adjacent to the first syndicated content item in the RSS feed ... in response to a request for the RSS feed," as recited by claim 1.

#### VI. RSS Advertising Fails to Cure the Deficiencies of Sheth

At page 7 of the office action, the Examiner states that "Sheth does not teach the targeted ad item location in the RSS feed being adjacent to the syndicated content item. RSS Advertising (p. 1 of 8) [sic] the targeted ad item location in the RSS feed being adjacent to the syndicated content item." Even if the Examiner's interpretation of RSS Advertising is correct (which applicant does not concede), RSS Advertising does not disclose inserting ... the first targeted ad item at a location in the RSS feed ... in response to a request for the RSS feed. For example, RSS Advertising recites **"embedding** text ads into RSS feeds," which is not the same as inserting an ad item into an RSS feed **in response to a request for the RSS feed."**

For example, paragraph 0035 of the present application recites that

embedding an advertisement directly into an original syndication feed can result in the advertisement not being well targeted to the viewer of the feed. Moreover, because syndicated feeds may be provided over extended periods of time, an advertisement embedded into the original syndication feed may be substantially out of date by the time it is viewed. Similarly, if ads compete with one another (e.g., for placement in the RSS feed) using offer information ... from advertisers' accounts or performance information ... such information may be stale by the time the ad is rendered, selected, etc. For example, an advertiser may have reached a budget limit or closed their account. In addition, having the advertisement embedded into the original syndication feed complicates tracking and viewing of advertisements by end users....

Paragraphs 0014 and 0044, described above, specify advantages of inserting ad items response to a request for the RSS feed, rather than embedding the ad items in the RSS feeds. Thus, RSS Advertising does not cure the deficiencies of Sheth specified above.

V. Conclusion

For the reasons set forth above, Sheth fails to teach, describe, or otherwise suggest "inserting ... the first targeted ad item at a location in the RSS feed [that] is adjacent to the first syndicated content item in the RSS fee ... in response to a request for the RSS feed," as recited by independent claim 1. Therefore, the rejection of claim 1 in view of Sheth should be withdrawn. Additionally, for the reasons provided above, RSS Advertising fails to cure the deficiencies of Sheth.

No fees are believed to be due. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: \_\_\_\_\_

9/9/10



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